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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/664,473

09/18/2000

Hugh Sharkey

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25-31-0023

6257

7590

06/15/2006

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3735

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/664,473

**Applicant(s)**

SHARKEY

**Examiner**

david shay

**Art Unit**

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on March 20, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 57-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>May 24, 2006</u> . | 6) <input type="checkbox"/> Other: _____  |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 20, 2006 has been entered.

Applicant has amended the section of the specification identifying applications which are relied upon for continuity under 1.120. This amendment is objected to as inaccurate. The contents of the instant application and 08/696,051 (hereinafter "the parent") appear to be the same. However, this application does not claim the parentage of the instant application, and thus this application cannot be properly termed a "continuation" thereof, since the parent claims it is a "continuation" and that its specification was originally filed as the specification of 08/888,359, which also claims to be a "continuation" of 08/390,873. Thus asserting that the instant case is a "continuation of 08/696,051 and a CIP of 08/390,873, of which 08/696,051 is also purported to be a "continuation" is improper.

Applicant argues that Sand ('709) teaches away from the use of RF energy at column 3, lines 11-22. The examiner respectfully notes that in this passage, Sand ('709) teaches away from the use of RF energy to shrink **corneal** collagen, as clearly set forth in the cited passage, there is no hint that the variation in topography of a few microns – a distance which yields a huge change in refractive performance of the cornea is problematic for vascularized tendons, which are hundreds of microns in diameter. It is also further shown by Anderson et al to be an acceptable energy to heat tissue such as tendons.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not consistently identify the applications under which the benefit of 35 U.S.C. 120 is being claimed.

A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 57-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand ('709) in combination with Anderson ('216). Sand ('709) teaches a method such as claimed except the use of RF, use of painting strokes, and use on patellar tendons per se. Anderson ('216) teaches equivalence of RF energy and laser energy for heating tissue. It would have been obvious to artisan of ordinary skill to employ RF energy in the method of Sand ('709) since this is not critical and these are equivalent for tissue heating, as taught by Anderson ('216) to employ the method on patellar tendons, since Sand ('709) does not discuss avoiding these structures when heating tendons attaching the long bones; to employ a painting motion, since this would allow a substantial length of the tendon to be treated all at once, and to deflect the probe, as taught by Anderson et al, since Sand ('709) teaches no particular technique to reach the internal tissues

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which are contemplated to be treated, and since this is not critical, thus producing a method such as claimed.

Claim 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand ('709) in combination with Anderson ('216) as applied to claims ~~57 and 61~~<sup>57</sup>-66 above, and further in view <sup>of</sup> Makower et al. Makower et al teach the desirability of insulating tissue that is not desired to be affected by the heat application. It would have been obvious to the artisan of ordinary skill to insulate portions of the tissue which are not desired to be affected since this would prevent undesirable heating in the tissue, thus producing a method such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 5,458,596. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C.

Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,785,705. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,954,716. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C.

Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,068,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,169,926. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C.

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Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,246,913. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,391,028. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C.



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Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,482,204. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 57-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 90-93 of U.S. Patent Application No. 08/714,987 in view of Sand ('709). Sand ('709) teaches the use of applied surface applied energy to shrink tendon tissue. It would have been obvious to the artisan of ordinary skill to employ the method claimed in the shrinking of tendons, since this will enable

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musculoskeletal and cosmetic surgeries, as taught by Sand ('709), thus producing a method such as claimed.

This is a provisional obviousness-type double patenting rejection.

Claims 57-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim s 1-11, 13, 14, 16, 18-22 of copending Application No. 11/112,164 in view of Sand ('709). Sand ('709) teaches the use of applied surface applied energy to shrink tendon tissue. It would have been obvious to the artisan of ordinary skill to employ the method claimed in the shrinking of tendons, since this will enable musculoskeletal and cosmetic surgeries, as taught by Sand ('709), thus producing a method such as claimed.

This is a provisional obviousness-type double patenting rejection.

Applicant's arguments filed November 22, 2005 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Applicant's arguments with respect to claim 67 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam, can be reached on Monday, Tuesday, Wednesday, and Thursday at (571) 272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'D. M. Shay', with a stylized flourish at the end.

DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330